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Paper No. 2

ENZO BIOCHEM, INC.
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NEW YORK NY 10022

MAILED

JUN 04 2009

OFFICE OF PETITIONS

In re Application of	:	
Engelhardt	:	ORDER TO SHOW CAUSE WHY
Application No. 08/182,621	:	DECISIONS REVIVING APPLICATION
Filed: January 13, 1994	:	SHOULD NOT BE VACATED
Atty Docket No. ENZ52	:	

This is an Order to Show Cause why the decisions mailed March 6, 1995, November 26, 1996 and April 15, 1998 in application No. 08/182,621 reviving the application should not be vacated.

Applicants are given **TWO MONTHS** from the mailing date of this Order to respond. This period is not extendable. A response must be filed in each of the subject applications for which applicant seeks relief from this Order. See 37 CFR 1.4(d).

FACTS

The ENZO applications at issue became abandoned at the end of the shortened statutory periods for failure to file responses to outstanding Office actions. No petitions for extensions of time for response were filed in any of the applications. Notices of Abandonment were mailed in each application. Enzo later filed petitions to revive that were granted. The following tables set forth the relevant ENZO applications, by application number, mailing date of Office action, date of abandonment, mailing date of notice of abandonment, date of filing of petition to revive, and date of mailing of decision granting petition to revive. The data is arranged in chronological order according to the date a petition to revive was filed starting with the earliest date, 23 December 1992, and ending with the latest date, 29 November 2005.

Application	Office Action	Abandoned ¹	Notice of	Petition	Decision
Number	Mailed		Abandon	Filed	Date
	26-Sep-91	26-Dec-91	05-May-92	23-Dec-92	29-Jan-93
	13-Apr-92	13-Jul-92	16-Nov-92	15-Jan-93	12-Feb-93
	01-Mar-93	01-Jun-93	01-Oct-93	16-Nov-93	10-May-94
	04-Nov-93	04-Feb-94	09-Jun-94	03-Feb-95	20-Mar-95
	08-Sep-94	08-Dec-94	17-Apr-95	07-Jun-95	17-Jun-96
08182621	31-Oct-95	30-Nov-95	12-Jun-96	01-Oct-96	26-Nov-96
	28-Dec-95	28-Mar-96	22-Jul-96	28-Mar-97	09-Jul-97
	28-Feb-96	28-May-96	27-Sep-96	29-May-97	14-Jul-97
	04-Apr-96	04-Jul-96	14-Nov-96	03-Jul-97	17-Nov-98
	25-Nov-96	25-Feb-97	23-Jun-97	25-Nov-97	09-Feb-98
	27-Nov-96	27-Feb-97	21-Jul-97	26-Nov-97	24-Feb-98
08182621	09-Apr-97	09-Jul-97	12-Nov-97	03-Feb-98	15-Apr-98
	26-Nov-97	26-Feb-98	17-Jul-98	20-Nov-98	06-Jul-99
	05-Sep-98	05-Sep-98	15-Dec-98	15-Mar-99	01-Jun-99
	07-Jul-98	07-Oct-98	02-Mar-99	02-Jun-99	21-Jun-99
	13-Apr-99	13-Jul-99	23-Nov-99	23-Feb-00	19-Jul-00
	04-Oct-00	04-Nov-00	25-Apr-01	26-Jul-01	09-Aug-01
	12-Sep-00	12-Dec-00	26-Mar-01	12-Dec-01	04-Jun-02
	06-Dec-00	06-Mar-01	28-Aug-01	06-Mar-02	26-Mar-02
	28-Feb-01	28-May-01	23-Oct-01	28-May-02	27-Sep-02
	13-Mar-01	13-Jun-01	05-Nov-01	13-Jun-02	31-Jul-02
	02-Oct-01	02-Jan-02	05-Jun-02	02-Jan-03	24-Jan-03
	18-Jun-02	18-Sep-02	08-Apr-03	06-Aug-03	27-Jul-04
	20-May-02	20-Aug-02	08-Jan-03	20-Aug-03	07-Dec-04
	06-Dec-02	06-Mar-03	23-Sep-03	20-Nov-03	11-Apr-06
	22-Apr-03	22-Jul-03	16-Dec-03	08-Dec-03	07-May-04
	12-Feb-04	12-May-04	28-Oct-04	04-Nov-04	28-Jan-05
	02-Mar-05	02-Jun-05	15-Nov-05	29-Nov-05	13-Feb-06

* It is noted that no Order to Show Cause has been issued in some of the applications listed in the table. These applications are currently abandoned. Further, Office records support a conclusion that there are no claims for the benefit of priority to these applications. Thus, the Office has concluded that it is unnecessary to issue an Order to Show Cause in these applications.

¹ These applications went abandoned for failure to respond to an outstanding Office action within the shortened statutory period for reply. The dates set forth in the table reflect the ending date of the shortened statutory period set forth in the Office action. If the Office action was a Non-final or Final rejection then the shortened statutory period is three (3) months. However, if the Office action was a restriction requirement or a notice to comply with 37 CFR 1.821 et seq., the shortened statutory period is one (1) month or 30 days, whichever is longer. No extensions of time for response were filed.

Each petition to revive included payment of the petition fee, a proposed response² and a statement of unintentional delay. Many cases included statements by attorney Ronald Fedus, Corporate Counsel for Enzo, such as that "the delay in taking action was unintentional." In some cases, attorney Fedus noted that the petition was being made within one year of the date of abandonment pursuant to 37 CFR 1.137(b).

During all periods relevant to the decisions on petition in the above-identified applications, Enzo was required to show that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Further, the Director could require additional information where there was a question whether the delay was unintentional. The decisions granting the petitions were based on the statement of unintentional delay, that the "delay in taking action was unintentional" or otherwise, that "the entire delay in filing the required reply from the due date for the reply to the date of filing of a grantable petition was unintentional." When the language of the statement varied from that required under 37 CFR 1.137(b), the petitions examiner specifically noted that the statement presented (the "abandonment was unintentional") did not comply with 37 CFR 1.137(b), as is Office practice. For example, in one application, the petitions examiner stated that the statement was accepted as meaning that the "delay was unintentional." Petitioner was advised to provide a statement to that effect if the Office's interpretation was incorrect. Further, petitioner was reminded that:

A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition under 37 CFR 1.137(b) was unintentional.

² 37 CFR 1.137(c) applies to the reply requirement for petitions under 37 CFR 1.137(a) and (b). In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination (RCE) in compliance with 37 CFR 1.114.

BASIS FOR ORDER

It is well established that an applicant is expected to exercise diligence throughout the prosecution of their application. By statute, 35 U.S.C. 133, upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, the application will be regarded as abandoned. This requirement of diligence extends to the requirement to take action upon becoming aware that the application has become abandoned.

For a decision granting revival based on unintentional delay to be proper, the statement that the delay was unintentional must be appropriately made. The Patent and Trademark Office does not have authority to revive *intentionally* abandoned applications. The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director (formerly Commissioner) to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that 35 U.S.C. § 41(a)(7) grants the Office more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances. However, that discretion is not boundless:

"[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71.

The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation. Likewise, the revival of an abandoned application based on an inappropriately made statement that the abandonment was unintentional is contrary to the meaning and intent of the statute and regulation.

In a situation where an application has been abandoned for less than a year and there is no reason to believe that the abandonment was intentional (e.g., an express abandonment letter in the record), a description of the circumstances surrounding the abandonment may be provided but is not required. A mere

statement by a proper party that the abandonment was unintentional is all that is required.

A statement made by a proper party (i.e. the party (or a registered practitioner on their behalf)) having the right or authority to reply (or not to reply) to avoid abandonment is generally accepted as appropriately made. This is because the applicant is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when this statement is provided to the Office. In addition, providing an inappropriate statement in a petition under 37 CFR 1.137(b) to revive an abandoned application may have an adverse effect when attempting to enforce any patent resulting from the application. See *Lumenyte Int 'l Corp. v. Cable Lite Corp.*, Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional). For these reasons, the Office generally relies upon the applicant's duty of candor and good faith and accepts the statement that the abandonment was unintentional without requiring further information.

In each of the Enzo applications, attorney Fedus' or another practitioner's statement was accepted on the basis of their duty of candor and good faith as a registered practitioner to inquire into the underlying facts and circumstances of the abandonment when making a statement that the delay in taking action was unintentional. However, in each instance, applicant was directly advised by the petitions examiner or put on notice by the Office via the Manual of Patent Examination Policy (MPEP) that "[a] person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition under 37 CFR 1.137(b) was unintentional." See MPEP 711.03(c).

As further provided in MPEP 711.03(c):

The abandonment of an application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b), where the applicant deliberately permits the application to become abandoned. See *Application of G*, 11 USPQ2d at 1380. Likewise, where

the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b).

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because:

- (A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;
- (B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;
- (C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;
- (D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or
- (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

Moreover, an intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by:

- (A) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application;

(B) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or
(C) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention is the antithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

The Office may require an applicant to carry the burden of proof to establish that the delay from the due date for the reply until the filing of a grantable petition was unintentional within the meaning of 35 U.S.C. 41(a)(7) and 1.137(b) where there is a question whether the entire delay was unintentional. See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). Applicants' failure to carry the burden of proof to establish that the "entire" delay was "unintentional" may lead to the denial of the petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.

The question has now arisen as to whether the statements were appropriately made under the circumstances of the abandonment of these applications. To have been appropriately made, the statement of unintentional delay had to have supported a conclusion that the delay in filing a response and the delay in filing a petition were unintentional. The statement of unintentional delay is not appropriate where any of the delays are intentional.

The following table sets forth the number of days in delay from the date of abandonment of the application to the date the petition was filed (col. 5) and the number of days in delay from the date of the mailing of the notice of abandonment to the date of filing of the petition (col. 6).

Application	Abandoned	Notice of	Petition	Days	Days
Number		Abandon	Filed	After	After
				Abandoned	Notice
	13-Jul-92	16-Nov-92	15-Jan-93	186	60
	26-Dec-91	05-May-92	23-Dec-92	363	232
	01-Jun-93	01-Oct-93	16-Nov-93	168	46
	08-Dec-94	17-Apr-95	07-Jun95	181	51
	04-Feb-94	09-Jun-94	03-Feb-95	364	239
08182621	31-Jan-96	10-Jun-96	01-Oct-96	244	113
08182621	09-Jul-97	12-Nov-97	03-Feb-98	209	83
	04-Jul-96	14-Nov-96	03-Jul-97	364	231
	13-Jul-99	23-Nov-99	23-Feb-00	225	92
	27-Feb-97	21-Jul-97	26-Nov-97	272	128
	28-Mar-96	22-Jul-96	28-Mar-97	365	249
	28-May-96	27-Sep-96	29-May-97	366	244
	26-Feb-98	17-Jul-98	20-Nov-98	267	126
	25-Feb-97	23-Jun-97	25-Nov-97	273	155
08822963	05-Sep-98	15-Dec-98	15-Mar-99	191	90
	07-Oct-98	02-Mar-99	02-Jun-99	238	92
	20-Aug-02	08-Jan-03	20-Aug"03	365	224
	06-Mar-01	28-Aug-01	06-Mar-02	365	190
	18-Sep-02	08-Apr-03	06-Aug-03	322	120
	13-Jun-01	05-Nov-01	13-Jun-02	365	220
	12-Dec-00	26-Mar-01	12-Dec-01	365	261
	04-Jan-01	25-Apr-01	26-Jul-01	203	92
	02-Jan-02	05-Jun-02	02-Jan-03	365	211
	22-Jul-03	16-Dec-03	08-Dec-03	139	-8
	28-May-01	23-Oct-01	28-May-02	365	217
	06-Mar-03	23-Sep-03	20-Nov-03	259	58
	02-Jun-05	15-Nov-05	29-Nov-05	180	14
	12-May-04	28-Oct-04	04-Nov-04	176	7

A review of several applications owned by ENZO reveals that there was a pattern of abandoned applications and delayed revivals. For example, of 28 occurrences of revival of ENZO applications, 11 have been identified where applicant waited almost a year (in fact, exactly 364 to 366 days) to file a petition to revive. Further, of those 28 occurrences, in 20 instances, applicant waited 3 months or more after the mailing of the notice of abandonment to file a petition to revive. Only 7 times did applicant file a petition to revive within 2 months of the mailing of the notice of abandonment. This pattern was

not before the Office when the decisions were made to grant the petitions to revive in the various applications.

Given all of this information, a question is raised as to whether in each application i) applicant deliberately chose not to respond to the Office action and to allow the application to become abandoned, ii) applicant deliberately chose not to seek revival of an abandoned application, or iii) applicant deliberately chose to delay seeking the revival of the abandoned application.

Under the circumstances, beyond the statement that the delay in taking action was unintentional, additional explanation is required. Accordingly, the Office is requiring applicant to show cause as to why the decision granting the petition to revive in each of the involved applications should not be vacated.

The Office is requiring further information as to i) the cause of the delay between the date the application became abandoned and the date a grantable 37 CFR 1.137(b) petition was filed, ii) the cause of the delay between the date the applicant was first notified that the application was abandoned and the date a grantable 37 CFR 1.137(b) petition was filed, and iii) how these delays were "unintentional." Further, if there was a delay in discovering the abandoned status of the application, a showing as to how the delay occurred despite the exercise of due care or diligence on the part of the applicant. What caused the delay in filing the petition to revive until just before the end of the one-year period? In essence, what is applicant's basis for the assertion that the delay was unintentional within the meaning of 35 U.S.C. 41(a)(7) and 37 CFR 1.137(b)?

Where any single application was abandoned and revived on multiple occasions, the response to this Order should address each occasion. This is regardless of whether the tables set forth herein specifically note those abandonments.

Among whatever evidence the applicant deems necessary to adequately respond to the Order, the Office is requiring an explanation of the docketing system used for recording due dates for response to an Office communication and how it operated. Upon receipt of an Office communication, how were the shortened statutory period for reply, statutory period for reply and

period for filing a petition to revive docketed? How is it that a significant number of petitions were filed on the 363rd - 365th day of abandonment? Was the one-year period to file a petition to revive specifically docketed? When electing to file a continuing application rather than a reply to an Office action, how was copendency verified? In other words, what is Enzo's explanation for the delay in filing a petition to revive solely for the purposes of continuity? Enzo's response should include copies of the relevant docket entries, including a showing of what action (or inaction) was docketed for a date three months from the mail date of the Office action (or one month in the instance of a restriction requirement or notice to comply); what action (or inaction) was docketed for a date six months from the date of the end of the statutory period for reply (or seven months in the instance of a notice to comply); and what action was docketed for a date 1 year from the date of likely abandonment (both counting 1 year from the end date of expiration of the shortened statutory period and 1 year from the end date of the statutory period for reply). It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Further correspondence with respect to this Order should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (571) 273-8300
 ATTN: NANCY JOHNSON
 SENIOR PETITIONS ATTORNEY

By hand: Customer Service Window
 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Charles Pearson", with a long horizontal flourish extending to the right.

Charles Pearson
Director
Office of Petitions

STATUTES, RULES AND REGULATIONS

Effective December 1, 1997, relevant statutes and regulations read, in pertinent part, as follows:

35 U.S.C. 133:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

37 CFR 1.137(b):

When the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

[47 FR 41277, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) 48 FR 2713, Jan. 20, 1983, effective Feb. 27, 1983; paras. (a) - (c), paras. (d) & (e) added, 58 FR 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (c) revised, 60 FR 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 FR 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised, 65 FR 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)(3) & (b)(3) revised, 68 FR 14332, Mar. 25, 2003, effective May 1, 2003; para. (d)(3) revised, 69 FR 56481, Sept. 21, 2004, effective Sept. 21, 2004; heading, paras. (a) introductory text, (b) introductory text, and (e) revised, 72 FR 18892, Apr. 16, 2007, effective May 16, 2007]

Effective June 8, 1995, relevant statutes and regulations read, in pertinent part, as they read September 20, 1993. 37 CFR 1.137(c) was revised with respect to the requirement for a terminal disclaimer.

Effective September 20, 1993, relevant statutes and regulations read, in pertinent part, as follows:

35 U.S.C. 133

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

37 CFR 1.137(b):

An application unintentionally abandoned for failure to prosecute may be revived as a pending application if the delay was unintentional. A petition to revive an abandoned application must be promptly filed after the applicant is notified of, or otherwise becomes aware of, the abandonment, and must be:

(1) accompanied by a proposed response to continue prosecution of that application, or filing of a continuing application, unless either has been previously filed;

(2) accompanied by the petition fee as set forth in § 1.17(m);

(3) accompanied by a statement that the delay was unintentional. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) filed either:

(i) within one year of the date on which the application became abandoned; or

(ii) within three months of the date the first decision on a petition to revive under paragraph (a) of this section which was filed within one year of the date on which the application became abandoned³.

See Manual of Patent Examination Procedure (MPEP), Fifth Edition, Rev. 16 (March 1994).

³ Effective December 1, 1997, 37 CFR 1.137(b) was revised to eliminate the one year bar (62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997).